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Remarks:

*Amendments to the specification and claims:*

Claims 3, 5, 7, 8, 10-15, 18 and 19 are pending in this application. By this Amendment, the specification and claims 5, 7, 10, 11, 12 and 14 are amended and claims 1, 2, 4, 9, 16 and 17 are canceled. The specification is amended to correct typographical errors and to address an objection to the specification.

No new matter is added to the application by this Amendment.

*Regarding the objection to the specification for alleged informalities:*

The disclosure was objected to for alleged informalities. This objection is respectfully traversed.

Specifically, the specification was objected to for allegedly containing a typographical error where J is representing what should be I. In response, the specification is amended to replace the term "J" with the term "I" as suggested by the Patent Office.

Thus, Applicant respectfully request withdrawal of the objection to the specification.

*Regarding the objection of claim 9 for allegedly informalities:*

Applicants respectfully traverse the objection of the foregoing claim.

In view of the cancellation of claim 9, this objection is moot.

Applicants respectfully request withdrawal of the objection to the claim.

*Regarding the rejection of claims 1-3 and 12-15 under 35 USC 102(b) as allegedly being anticipated by US 2,197,479 to Meigs:*

Applicants respectfully traverse the rejection of the foregoing claim in view of Meigs.

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Prior to discussing the relative merits of the Patent Office's rejection, Applicant points out that unpatentability based on "anticipation" type rejection under 35 USC 102(b) requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee"). Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v.*

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*Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

The Patent Office alleges that Meigs discloses each and every feature of claims 1-3 and 12-15. Applicants respectfully disagree with the allegations by the Patent Office.

In view of the cancelation of claims 1 and 2, this rejection is moot with respect to those claims.

Present claim 3 is directed to a fragrance composition and present claims 12-15 are directed to a method of manufacturing a fragrance application.

In contrast, Meigs discloses ether-alcohol carbamates and new compositions of matter employing the ether-alcohol carbamates whereby the compositions of matter are particularly useful in the coating of plastic arts and serve as plasticizers or softeners (see col. 1, lines 27-37). Additionally, Meigs discloses that the ether-alcohol carbamates are generally colorless, odorless, essentially tasteless, substantially non-volatile at ordinary temperatures and pressures and non-toxic (see col. 2, line 17-20).

Unlike the presently claimed invention, Meigs' ether-alcohol carbamates are odorless compounds. The odorless ether-alcohol carbamates usable in coating plastic and as plasticizers or softeners according to Meigs do not disclose a fragrance composition as recited in claim 3 and a method of manufacturing a fragrance application as required by claims 12-15. Moreover, the teachings of Meigs, which are directed to odorless ether-

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alcohol carbamates, are clearly not relevant to the presently claimed fragrance compositions and methods for manufacturing a fragrance application.

Because the features of independent claims 1, 12 and 14 are not disclosed by Meigs, Meigs cannot anticipate, nor would not have rendered obvious, the features specifically defined in claims 1, 12 and 14 and their dependent claims.

For at least these reasons, claims 3 and 12-15 are patentably distinct from and/or non-obvious in view of Meigs. Reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. 102(b) are respectfully requested.

*Regarding the rejection of claims 1, 4, 7, 8, 16 and 17 under 35 USC 102(b) as allegedly being anticipated by US 4,382,765 to Moller et al. (hereinafter "Moller"):*

Applicants respectfully traverse the rejection of the foregoing claims in view of Moller.

The Patent Office alleges that Moller discloses each and every feature of claims 1, 4, 7, 8, 16 and 17. Applicants respectfully disagree with the allegations by the Patent Office.

In view of the cancellation of claims 1, 4, 16 and 17, this rejection is moot with respect to those claims.

Moller discloses a skin-care, skin-protection, and skin-cleaning agent composition containing at least one substituted carbamide acid ester or N-alkenyl polymer as a skin moisturizing agent (see col. 1, lines 44-48). All examples of Moller are secondary carbamates except Example (I) (see col. 5, lines 4-66). Only Example (I) is a tertiary carbamate. However, Example (I) does not disclose the fragrance ingredient required by claim 3, from which claims 7 and 8, directly or indirectly depend, because the condition that R, R<sup>1</sup> and R<sup>2</sup> having together 7 to 18 carbon atoms is not fulfilled. Specifically, the condition is not fulfilled because Example (I), N-(2-hydroxyethyl)-oxazolidine-2-one,

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comprises only 4 carbon atoms (plus the carboxylic group). Accordingly, Moller does not disclose the fragrance ingredient as recited in claim 3.

Perfumes are mentioned as conventional constituents which may be present in a cosmetic product. Specifically, Moller discloses that the skin care, protection and cleaning agents are mixed with other perfume oils (see col. 1, lines 64-68 and Examples 1 and 3) as acknowledged by the Patent Office (see page 5 of the Office Action). The compounds of the present invention are used in any field of fine and functional perfumery, such as perfumes, but the compounds are not mixed with other perfume oils as taught by Moller. Moreover, Examples 1 and 3 of Moller as cited by the Patent Office do not disclose the fragrance ingredient as required by claim 3.

Because the features of independent claim, 3 from which claims 7 and 8 depend, are not disclosed by Moller, Moller cannot anticipate, nor would not have rendered obvious, the features specifically defined in claim 3 and its dependent claims.

For at least these reasons, claims 7 and 8 are patentably distinct from and/or non-obvious in view of Moller. Reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. 102(b) are respectfully requested.

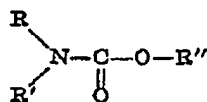
*Regarding the rejection of claim 5 under 35 USC 102(b) as allegedly being anticipated by US 3,203,853 to Jager et al. (hereinafter "Jager"):*

Applicants respectfully traverse the rejection of the foregoing claim in view of Jager.

The Patent Office alleges that Jager discloses each and every feature of claim 5. Applicants respectfully disagree with the allegations by the Patent Office.

Jager discloses a synergistic effect when combining active and certain inactive carbamate esters possessing insecticidal effects. The class of inactive carbamate esters disclosed by Jager is very broadly defined. Specifically, Col. 1, lines 44-67 of Jager discloses:

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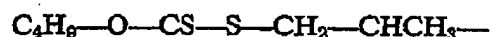
In the inactive carbamate esters of this invention R may be hydrogen, an alkyl, alkylenyl, cycloalkyl, aralkyl, or nitroso radical; R' may be hydrogen, an alkyl, alkylenyl, cycloalkyl, aralkyl, or substituted phenyl radical. R and R' together with the nitrogen atom of the carbamic acid structure may also form a heterocyclic ring which may also contain hetero atoms other than the aforementioned nitrogen atom; R'' may be an alkyl, alkylenyl radical, a chain containing a plurality of carbon atoms together with oxygen, sulfur, or nitrogen atoms, or any one of these radicals further substituted by an aryloxy radical, a phenyl radical, and particularly an alkyl substituted phenyl radical, and a cycloalkyl radical. In preferred embodiments of this invention, R'' is a phenyl radical, an alkyl substituted phenyl radical, a cycloalkyl radical, an ethylmercaptoethyl radical, an allyloxyethyl radical, a phenoxyethyl radical, or a radical of the formula

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MPEP 2131.02 sets forth:

If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be "at once envisaged." One may look to the preferred embodiments to determine which compounds can be anticipated. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962).

Turning to the preferred embodiments of Jager, out of nine specific examples of inactive esters, only inactive ester Example (9) is a tertiary carbamate ester, namely, 2-isopropyl-3-methylphenyl-N-diisopropylcarbamate. However, the compound of Example (9) does not disclose the specifically defined features of presently claimed compound.

Applicants submit that the disclosed broadly defined genus of Jager does not anticipate the claimed compound. Additionally, Jager fails to disclose a smaller genus of

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compounds or a smaller preferred subgenus of the broadly defined genus. Thus, Jager does not anticipate compounds of one or more smaller genus or subgenus of the broadly defined genus because Jager fails to specifically describe a smaller genus or subgenus of compounds.

Because the features of claim 5 are not disclosed by Jager, Jager cannot anticipate, nor would not have rendered obvious, the features specifically defined in claim 5.

For at least these reasons, claim 5 is patentably distinct from and/or non-obvious in view of Jager. Reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. 102(b) are respectfully requested.

*Regarding the rejection of claim 4 under 35 USC 103(a) as allegedly being unpatentable over US 5,472,946 to Peck et al. (hereinafter "Peck"):*

Applicants respectfully traverse the rejection of the foregoing claim in view of Peck.

In view of the cancellation of claim 4, this rejection is moot.

Applicants respectfully request withdrawal of the rejection to the claim.

*Regarding the rejection of claims 5, 10, 11, 18 and 19 under 35 USC 103(a) as allegedly being unpatentable over Jager in view of Moller:*

Applicants respectfully traverse the rejection of the foregoing claims in view of Jager and Moller.

Prior to discussing the merits of the Examiner's position, the undersigned reminds the Examiner that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary

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considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). There must be some suggestion, teaching, or motivation arising from what the prior art would have taught a person of ordinary skill in the field of the invention to make the proposed changes to the reference. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). But see also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

The Patent Office acknowledges that Jager fails to accentuate the applications of the chemicals in Jager's genus chemicals towards applications of fragrance products. The Patent Office introduces Moller as allegedly teaching applications of similar products, in Applicants' chemical genus, used in similar applications to those claimed by the



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Applicants. The Patent Office alleges that it would have been obvious at the time of the invention to have used similar chemicals for similar applications for a successful product, ready for improvement, to yield predictable results. The Patent Office cites Eddy et al. (hereinafter "Eddy") as an informational reference which allegedly teaches (1) odorous or fragranting chemicals are known to have applications of the type indicated by Jager and (2) two chemicals in Applicants genus (N-ethyl-N-phenylurethane and N-methyl-N-phenylurethane. Applicants respectfully disagree with the allegations by the Patent Office.

MPEP 2144.08 sets forth:

The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious."); *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (Federal Circuit has "decline[d] to extract from *Merck & Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it."). See also *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995).

As discussed above with respect to the rejection relying solely on Jager, only one out of nine preferred embodiments of Jager is a tertiary carbamate ester, namely, 2-isopropyl-3-methylphenyl-N-diisopropylcarbamate. Additionally, the compound of Example (9) does not teach or suggest the specifically defined features of the compound recited in claim 3 (from which claims 10 and 11 directly depend) and claim 5 (from which claims 18 and 19, directly or indirectly, depend).

Moller does not remedy the deficiencies of Jager as set forth above with respect to claims 3 and 5. At best, Moller teaches Example (I) which is a tertiary carbamate. However,

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Example (I), namely N-(2-hydroxyethyl)-oxazolidine-2-one, does not disclose the fragrance ingredient and compound (I) as recited in claims 3 and 5, respectfully.

Additionally, as discussed above with respect to the rejection relying solely on Moller, the skin care, protection and cleaning agents of Moller are mixed with other perfumes. In contrast, the compounds of the present invention are used in any field of fine and functional perfumery, such as perfumes, but the compounds are not mixed with other perfume oils as taught by Moller.

Accordingly, Jager and Moller, taken singly or in combination, fail to teach or suggest a fragrance composition comprising as a fragrance ingredient a carbamate of formula (I) as required by claim 3, from which claims 10 and 11 depend. Moreover, Jager and Moller, taken singly or in combination, fail to teach or suggest a compound of formula (I) as recited in claim 5, from which claims 18 and 19 depend.

Eddy teaches test results for about 180 materials with regard to their suitability against body lice. It is said that approximately half of the tested materials which were classified under the section heading "MATERIALS GIVING COMPLETE KNOCK-DOWN OF LICE IN 1 HOUR" failed to pass toxicological tests, and many others either stained badly or had an objectionable odor (see page 764, col. 2, first full paragraph and page 766). However, contrary to the allegations of the Patent Office, nothing in Eddy teaches or suggests that some of the compounds of Eddy may be suitable as fragrance ingredient. Instead, Eddy teaches away from a compound usable as a fragrance ingredient because Eddy's compositions have an objectionable odor. Moreover, a skilled artisan would not be motivated to use Eddy's compounds having an objectionable odor to achieve the present invention.

Because these features of independent claims 3 and 5 are not taught or suggested by Jager and Moller, taken singly or in combination, these references would not have rendered the features of claims 5, 10, 11, 18 and 19 obvious to one of ordinary skill in the art.

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In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

*Regarding the rejection of claim 9 under 35 USC 103(a) as allegedly being unpatentable over US 2,517,965 to Bohl in view of US 6,399,808 to Jung:*

Applicants respectfully traverse the rejection of the foregoing claim in view of Bohl and Jung.

In view of the cancellation of claim 9, this rejection is moot.

Applicants respectfully request withdrawal of the rejection to the claim.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

The early issuance of a *Notice of Allowability* is solicited.

#### **PETITION FOR A ONE-MONTH EXTENSION OF TIME**

The applicants respectfully petition for a one-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

#### **CONDITIONAL AUTHORIZATION FOR FEES**

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, including any extension of time fees, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

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Respectfully Submitted;



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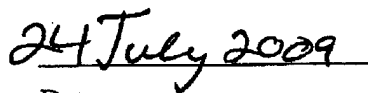
Date:

CERTIFICATION OF TELEFAX TRANSMISSION:

I hereby certify that this paper and all attachments thereto is being telefax transmitted to the US Patent and Trademark Office to telefax number: 571 273-8300 on the date shown below:



Allyson Ross



Date:

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